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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,501	12/14/2001	Gennady V. Merkulov	CL00001177DIV2	3922

25748                      7590                      03/03/2004

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EXAMINER

FRONDA, CHRISTIAN L

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

### Office Action Summary

**Application No.**

10/014,501

**Applicant(s)**

MERKULOV ET AL.

**Examiner**

Christian L Fronda

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,8,9 and 24-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,8,9 and 24-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/11/02</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

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## DETAILED ACTION

### *Election/Restriction*

1. Applicants' election of Group II, claims 4, 5, 8-11, 22, and 23 in the **RESPONSE TO RESTRICTION AND PRELIMINARY AMENDMENT** dated 12/15/2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Applicants' cancellation of claims 1-3, 5-7, 10-23, and addition of 24-37 is acknowledged.
3. Claims 4, 8, 9, and 24-37 are under consideration in this Office Action.

### *Claim Rejections - 35 U.S.C. § 101*

4. 35 U.S.C. 101 reads as follows:  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 4, 8, 9, and 24-37 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility.  
Applicants disclose the nucleotide sequence of SEQ ID NO: 1 and 3, the deduced amino acid sequence of the protein encoded as SEQ ID NO: 2, and assigned the protein of SEQ ID NO: 2 as a human metalloprotease protein which is a generic asserted utility. However, the specification does not disclose the specific function of the protein of SEQ ID NO: 2 or its specific relationship to any disease. Homology is not a disclosure of how to use the protein or polynucleotide encoding the protein of SEQ ID NO: 2. While the claimed invention can be used in gene and protein expression monitoring experimentations, the specification does not teach any meaningful interpretation of data collected from such experimentations. Nor does the specification teach how to use any identified compound which modulates the expression of the claimed invention.  
Substantial utility is one that provides a specific benefit in currently available form at the time of filing of the invention. However, the main utility of the nucleic acid and protein is to carry out further research to identify the biological function and possible diseases associated with the protein. Utilities that require or constitute carrying out further research to identify or

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reasonably confirm a specific use are not substantial utility and do not provide a specific benefit. Thus, the claimed invention has no specific or substantial asserted utility.

***Claim Rejections - 35 U.S.C. § 112, 1st Paragraph***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 4, 8, 9, and 24-37 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above in the rejection of claims 4, 8, 9, and 24-37 under 35 U.S.C. 101, one skilled in the art clearly would not know how to use the claimed invention.

8. Claims 31-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 31-37 are genus claims that are directed toward all possible polynucleotides having at least 90% homology to SEQ ID NOs: 1 or 3. The scope of the claim includes many polynucleotides with widely differing structural, chemical, and physical characteristics, and the genus is highly variable because a significant number of structural differences between genus members is permitted.

The specification, however, only provides the following representative species encompassed by these claims: a polynucleotide having a nucleotide sequence of SEQ ID NO: 1 or SEQ ID NO: 3. There is no disclosure of any particular structure to function/activity relationship in the single disclosed species. The specification also fails to describe additional representative species of these polynucleotides by any identifying structural characteristics or properties for which no predictability of structure is apparent.

Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention. Claims 32-37 which depend from claim 32 are also rejected because they do

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not correct the defect of claim 32.

9. Claim 31-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Factors to be considered in determining whether undue experimentation is required, are summarized in *re Wands* [858 F.2d 731, 8 USPQ 2nd 1400 (Fed. Cir. 1988)]. The *Wands* factors are: (a) the quantity of experimentation necessary, (b) the amount of direction or guidance presented, (c) the presence or absence of working example, (d) the nature of the invention, (e) the state of the prior art, (f) the relative skill of those in the art, (g) the predictability or unpredictability of the art, and (h) the breadth of the claim.

The nature and breadth of the claims encompass any polynucleotides having at least 90% homology to SEQ ID NOs: 1 or 3 of any biological function and biological utility.

The specification provides guidance and examples for making an isolated polynucleotide having a nucleotide sequence of SEQ ID NO: 1 or SEQ ID NO: 3. However, the specification does not teach the specific structural/catalytic amino acids and the structural motifs essential for protease activity/function which cannot be altered. The state of the art as exemplified by Attwood et al. (Comput. Chem. 2001, Vol. 25(4), pp. 329-39) is such that "...we do not fully understand the rules of protein folding, so we cannot predict protein structure; and we cannot invariably diagnose protein function, given knowledge only of its sequence or structure in isolation" (see Abstract and entire publication). Furthermore, Ponting (Brief. Bioinform. March 2001, Vol. 2(1), pp. 19-29) states that "...predicting function by homology is a qualitative, rather than quantitative, process and requires particular care to be taken...due attention should be paid to all available clues to function, including orthologue identification, conservation of particular residue types, and the co-occurrence of domains in proteins" (See Abstract and entire publication).

The standard for meeting the enablement requirement is whether one of skill in the art can make the invention without undue experimentation. The amount of experimentation to make the claimed polynucleotide is enormous and entails selecting specific nucleotides to change (deletion, insertion, substitution, or combinations thereof) in a polynucleotide to make a polynucleotide that has at least 90% homology to SEQ ID NOs: 1 or 3 and determining by assays whether the polypeptide has an protease activity. The specification does not provide guidance with respect to the specific structural/catalytic amino acids and the structural motifs essential for enzyme structure and activity/function which must be preserved. Thus, searching for the specific nucleotides to change (deletion, insertion, substitution, or combinations thereof) in a polynucleotide to make a polynucleotide has at least 90% homology to SEQ ID NOs: 1 or 3 is well outside the realm of routine experimentation and predictability in the art of success in

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determining whether the resulting polypeptide has protease activity is extremely low since no information is provided by the specification regarding the specific catalytic amino acids and the structural motifs essential for enzyme structure and activity/function which must be preserved.

The Examiner finds that one skilled in the art would require additional guidance, such as information regarding the specific catalytic amino acids and the structural motifs essential for activity/function which must be preserved. Without such a guidance, the experimentation left to those skilled in the art is undue. Claims 32-37 which depend from claim 32 are also rejected because they do not correct the defect of claim 32.

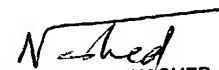
### *Conclusion*

10. No claim is allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L Fronda whose telephone number is (571)272-0929. The examiner can normally be reached Monday-Friday between 9:00AM - 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura N Achutamurthy can be reached on (571)272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLF

  
NASHAAT T. NASHED PHD.  
PRIMARY EXAMINER